

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-119 are currently pending. Claims 1, 12, 14-19, 27, 28, 31, 33-38, 44, 49, 53, 55, 57, 59, 61, 67, 71, 75, 77, 79, 81, 83, 89, 94, 96-101, 109, 110, 113, and 155-119 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-119 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,202,092 to Takimoto et al. (hereinafter “the ‘092 patent”) in view of U.S. Patent No. 5,509,074 to Choudhury et al. (hereinafter “the ‘074 patent”).

Amended Claim 1 is directed to a printing system, comprising: (1) a printing apparatus; (2) a terminal apparatus for transmitting information including a request to execute a specific print job and for receiving information; (3) notification means for notifying a registered user of the printing apparatus of information on authority of the registered user to use the printing apparatus to execute any print job prior to the transmission of the request to execute the specific print job to be printed by the printing apparatus, but after the registered user has established access to use of the printing apparatus, wherein the notification means is unaware of the specific print job when notifying the registered user; and (4) a network connecting the printing apparatus, the terminal apparatus, and the notification means so that information transmission and reception in the system is performed through an electrical signal via the network.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the ‘092 patent discloses everything in Claim 1 with the exception of “notifying a

user prior to the transmission of the request to execute the print job to be printed by the printing apparatus,”<sup>1</sup> and relies on the ‘074 patent to remedy that deficiency.

The ‘092 patent is directed to a print system including a shared printer on a network in which the authority of each user to use the printer is set in a security database. After a print request, including the number of sheets to be printed, is sent to a security validating device, the ‘092 patent discloses that the security validating device decides whether authorization to use the printer is to be granted based on the restrictions on the user maintained in the database and the status of the user. Further, the ‘092 patent discloses that, if the printing is authorized, the printing is completed and the status of the user is updated in the security database.

However, as admitted in the outstanding Office Action, the ‘092 patent fails to disclose means for notifying a registered user of the printing apparatus of information on authority of the registered user to use the printing apparatus to execute any print job prior to the transmission of the request to execute the specific print job to be printed by the printing apparatus, as recited in amended Claim 1. Further, Applicants respectfully submit that the ‘092 patent fails to disclose that the notification means is unaware of the specific print job when notifying the registered user, as recited in amended Claim 1.

The ‘074 patent is directed to a method of protecting electronically published materials including the step of receiving a request for documents from a user having a computer with a display device or a printer, wherein the request includes an identification of the user. Further, the ‘074 method includes the steps of authenticating the request with a copyright server; using the copyright server to direct a document server to act upon proper authentication of the request; using the document server to create a uniquely encoded, compressed, and encrypted document for each authenticated request; and forwarding the documents through the network to corresponding agents for each authenticated user. As

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<sup>1</sup> See page 4 of the outstanding Office Action.

shown in the flowchart of Figure 4, the '074 patent discloses that, in step 232, the request for documents is received along with a unique ID from a user computer via the network. In response, as shown in steps 234-246, the system authenticates the request and the documents are ultimately forwarded to the user who requested the documents.

However, Applicants respectfully submit that the '074 patent fails to disclose notification means for notifying a registered user of the printing apparatus of information on authority of the registered user to use the printing apparatus to execute any print job prior to the transmission of the request to execute the specific print job to be printed by the printing apparatus, but after the registered user has established access to use of the printing apparatus, wherein the notification means is unaware of the specific print job when notifying the registered user, as recited in amended Claim 1. Rather, the '074 patent is directed to a user obtaining a document from the document server if authorized to do so by the copyright server. Further, the '074 patent discloses that if the document is received by the user from the document server, it may be printed. In particular, the '074 patent is concerned with a specific document when notifying a user whether the specific document can be printed. As shown in the flowchart of Figure 4, the second step in the process is to receive a request for a document, along with a unique user ID. Thus, **the '074 patent discloses a system in which a specific print job is requested prior to a user being notified regarding any information regarding the authority of the user to print**. Applicants respectfully submit that the '074 patent is silent regarding notifying a registered user of information on authority of the registered user to use the printing apparatus to execute **any** print job prior to the transmission of a request to execute a **specific** print job as recited in Claim 1. The '074 patent does not disclose whether a user is able or not able to use a printing apparatus, but it is focused on whether a user can print a specific document. The '074 patent is not concerned with printer

security or whether a particular user can use a particular printer, but is directed to regulating access to specific documents, wherein one means of access is through printing.

In the outstanding Office Action, in the Response to Arguments section on pages 2 and 3, the Office Action asserts that the '074 patent discloses the notification means recited in Claim 1 because "a user makes a document print/display request using a Print/Display Agent 11/13 and therefore a notification is sure to follow."<sup>2</sup> However, as Claim 1 makes clear, the claimed notification precedes the request to execute a specific print job. Thus, it is unclear to Applicants how the '074 patent can read on the claimed notification means if, as stated in the outstanding Office Action, the '074 notification follows the request to print, since Claim 1 requires notification prior to the transmission of the request to print.

Further, Applicants note that the Office Action cites to column 4, lines 27-31 of the '074 patent, which states "as another feature for some embodiments of the present invention, in order for the user to activate display or print functions, the user may be required to input to the display or print agent, a unique identification number such as was used to make the initial request." Emphasis added. However, Applicants note that this disclosure is part of the first example disclosed by the '074 patent, which indicates, starting at column 4, line 13, that "when the user 117 wants to view or print a document, he must make a request for a document via network 109 by using a unique identification, such as a credit card number, or other relatively valuable number that a user would not be willing to give away to someone else for elicit purposes. The copyright server 107 will authenticate the user's request and then the document server 103 sends out an encrypted copy directly to the display device 121 or printer 123 available to user space 115." Thus, the reference to the "initial request" in line 31 of column 4 refers back to the "request for a document" in line 14 of column 4 of the '074 patent. In other words, the '074 patent is indicating that the user requests a document by

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<sup>2</sup> See page 2 of the outstanding Office Action. Emphasis added.

submitting the request along with a unique identification, and that once the request is granted and the document is encrypted and sent to a printer, the user must then, in one embodiment, also enters the same unique identification number that was previously entered to have the document printed.

However, Applicants note that **the entire description in column 4 of the '074 patent relates to the printing of a specific document that the user has already requested.** In contrast, the notification means recited in Claim 1 is directed to notifying a registered user of the printing apparatus of information on authority of the registered user to use the printing apparatus to execute **any** print job **prior** to the transmission of the request to execute the **specific** print job, wherein the notification means is unaware of the specific print job when notifying the registered user. Thus, the notifying recited in Claim 1 is directed to the authority of a user to use a particular printing apparatus, which because the notification occurs prior to the transmission of the request for a specific print job, the notification means is unaware of the specific print job, and therefore necessarily cannot base the notification to the user on a specific print job. Thus, it follows that what the user wishes to print is not pertinent to whether the user has authority to use a particular printing apparatus. In contrast, the '074 patent discloses that a copyright server is used to determine, based on the content of the document that is requested to print, whether printing of that document will be allowed. Thus, any notification to the user in the '074 system is based upon the specific document that has been requested, in contrast to the invention recited in Claim 1.

Thus, no matter how the teachings of the '092 and '074 patents are combined, the combination does not teach or suggest notification means for notifying a registered user of the printing apparatus of information on authority of the registered user to use the printing apparatus to execute any print job prior to the transmission of the request to execute the specific print job to be printed by the printing apparatus, but after the registered user has

established access to use of the printing apparatus, wherein the notification means is unaware of the specific print job when notifying the registered user, as recited in amended Claim 1. Accordingly, Applicants respectfully submit that amended Claim 1 (and all associated dependent claims) patentably define over any proper combination of the '092 and '074 patents.

Independent Claim 19 is directed to a printing apparatus that recites the notification means recited in Claim 1. Claim 27 is directed to a terminal apparatus but clarifies that the information as to the authority of the registered user to use the printing apparatus is determined without knowledge of the specific print job. Claim 38 is directed to a printing method that includes a step of setting authority of a registered user to use the printing apparatus to execute any print job, wherein the setting step is performed without knowledge of the specific print job. Claim 61 recites a step identical to that recited in Claim 38. Also Claim 83 is directed to a notification part that notifies the registered user of a printing apparatus of information on authority of registered user to use the printing apparatus to execute any print job wherein the notification part is unaware of the specific print job when notifying the registered user. Claim 101 also includes the notification part recited in Claim 83. Finally, Applicants note that Claim 109 recites the terminal apparatus wherein the information as to the authority of the registered user to use the printing apparatus is determined without knowledge of the specific print job. As discussed above, the combined teachings of the '092 and '074 patents fail to disclose these limitations. Accordingly, Applicants respectfully submit that the above independent claims patentably define over any proper combination of the '092 and '074 patents.

Thus, it is respectfully submitted that independent Claims 1, 19, 27, 38, 61, 83, 101, and 109 (and all associated dependent claims) patentably define over any proper combination of the '092 and '074 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

*Kurt M. Berger*

James J. Kulbaski  
Registration No. 34,648  
Attorney of Record

Kurt M. Berger, Ph.D.  
Registration No. 51,461

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 06/04)

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